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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/088,250	12/23/2002	David M. Fink	HMR2023 US PCT	9383
5487	7590	03/31/2004		
ROSS J. OEHLER AVENTIS PHARMACEUTICALS INC. ROUTE 202-206 MAIL CODE: D303A BRIDGEWATER, NJ 08807			EXAMINER WRIGHT, SONYA N	
			ART UNIT 1626	PAPER NUMBER

DATE MAILED: 03/31/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/088,250	<b>Applicant(s)</b> FINK ET AL.	
	<b>Examiner</b> Sonya Wright	<b>Art Unit</b> 1626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-139 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-139 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

### **DETAILED ACTION**

Claims 1-139 are pending in this application.

#### ***Election/Restrictions***

Claims 1-139 are drawn to more than one inventive concept (as defined by PCT Rule 13), and accordingly, a restriction is required according to the provision of PCT Rule 13.2.

PCT Rule 13.2 states that the international application shall related to one invention only or to a group of inventions so linked as to form a single general inventive concept (requirement of unity of invention).

PCT Rule 13.2 states that unity of invention referred to in Rule 13.1 shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features.

Annex B, Part 1(b), provides that "special technical features" mean those technical features which, as a whole, define a contribution over the prior art.

Annex B, Part 1 (e), provides combinations of different categories of claims and states:

"The method for determining unity of invention under Rule 13 shall be construed as permitting, in particular, the inclusion of any one of the following combinations of claims of different categories in the same international application:

(i) in addition to an independent claim for a given product, an independent claim for a process specially adapted for the manufacture of the said product, and an independent claim for a use of the said product, or

(ii) in addition to an independent claim for a given process, an independent claim for an apparatus or means specifically designed for carrying out the said process, or

(iii) in addition to an independent claim for a given product, an independent claim for a process specially adapted for the manufacture of the said product, and an independent claim for an apparatus or means specifically designed for carrying out the said process, . . ."

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This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

Due to the numerous variables in the claims, i.e. X, R1, R2, R3, etc. . . and their widely divergent meanings, a precise listing of inventive groups can not be made. The following groups are exemplary:

Group I, claims 1-120, 124, and 125, drawn to compounds and compositions of formula I, wherein X is N(CH<sub>3</sub>), R1 is OH or alkoxy, R2 is H or C1-C6 alkyl, R3 is indanyl, and R4 is H or C1-6 alkyl, classified in class 548 and subclass 356.1+.

Group II, claim 121, drawn to a compound wherein X is N(CH<sub>3</sub>) and R1 is C1-C6 alkyl, classified in class 548 and subclass 356.1+.

Group III, claim 122, drawn to a compound wherein X is O, R1 is H or C1-6 alkyl, and R2 is CH<sub>3</sub>, F, p-bromobenzene, p-nitrobenzene, or p-methylbenzene, classified in class 548 and subclass 356.1+.

Group IV, claims 123 and 126-136, drawn to methods of use for compound of formula I wherein X is N(CH<sub>3</sub>), R1 is OH or alkoxy, R2 is H or C1-C6 alkyl, R3 is adamantyl, and R4 is H or C1-6 alkyl, classified in class 548 and subclass 356.1+.

Group V, claim 137, drawn to a process for the preparation of a compound of the formula I, wherein X is N(CH<sub>3</sub>), R1 is OH or C1-6 alkoxy, R2 is H or C1-C6 alkyl, R3 is indanyl, and R4 is H or C1-6 alkyl, classified in class 548 and subclass 356.1+.

Group VI, claim 138, X is O, R1 is OH or C1-6 alkoxy, R2 is H or C1-C6 alkyl, R3 is indanyl, and R4 is H or C1-6 alkyl, drawn to a process for the preparation of a compound of the formula I, wherein classified in class 548 and subclass 356.1+.

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Group VII, claim 139, X is O, R1 is OH or C1-6 alkoxy, R2 is H or C1-C6 alkyl, R3 is (CH<sub>2</sub>)<sub>n</sub>Q wherein Q is thienyl, and R4 is H or C1-6 alkyl, drawn to a compound of formula I, classified in class 548 and subclass 356.1+.

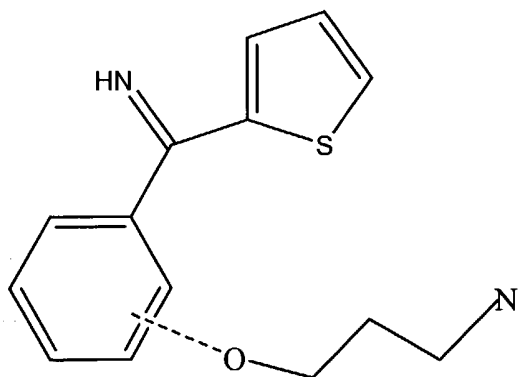
If Group I is elected, one method of use from Group IV, and one of process Groups V, VI, or VII should also be elected.

If Group II or III is elected, one method of use from Group IV should also be elected.

In accordance with 37 CFR 1.499, Applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted. Again, this list is not exhaustive. Setting forth an exhaustive list is difficult under the time constraints due to the sheer volume of subject matter instantly claimed. Therefore, Applicant may choose to elect a single invention by identifying another specific embodiment not listed in the exemplary groups of the invention and examiner will endeavor to group the same.

The inventions listed as Groups I-VII do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features that define a contribution over the prior art.

The compounds claimed contain a core of:



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The core does not define a contribution over the art, and the core contains variables such as X, R1, R2, R3, Z, etc. . . . The variables are broadly defined, and when the compound of formula I is taken as a whole, a plethora of vastly different compounds are possible. Each of the groups set forth above represents a discrete invention.

Accordingly, the unity of invention is considered to be lacking and restriction of the invention in accordance with the rules of unity of invention is considered to be proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143). Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).



Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sonya Wright, whose telephone number is (703) 308-4539. The examiner can normally be reached on Monday-Thursday from 7:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Joseph K. McKane, can be reached at (703) 308-4537. The Unofficial fax phone number for this Group is (703) 308-7921. The Official fax phone numbers for this Group are (703) 308-4556 or 305-3592.

When filing a FAX in Technology Center 1600, please indicate in the Header (upper right) "Official" for papers that are to be entered into the file, and "Unofficial" for draft documents and other communications with the PTO that are not for entry into the file of the application. This will expedite processing of your papers.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [joseph.mckane@uspto.gov]. All Internet e-mail communications will be made of record in the application file. PTO employees will not communicate with applicant via Internet e-mail where sensitive data will be exchanged or where there exists a possibility that sensitive data could be identified unless there is of record an express waiver of the confidentiality requirements under 35 U.S.C. 122 by the applicant. See the Interim Internet Usage Policy published by the Patent and Trademark Office Official Gazette on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist, whose telephone number is (703) 308-1235.

  
  
\_\_\_\_\_  
Joseph K. McKane  
Supervisory Patent Examiner  
Group 1600

Sonya Wright

March 23, 2004